REMARKS

Applicants thank Examiner Nguyen for the helpful and courteous discussion of February 8, 2011. During the discussion Applicants' U.S. representative pointed out that the U.S. PTO administrative guidelines set forth in the MPEP support withdrawal of the rejection for obviousness-type double patenting in view of the 11/311,134 application.

Applicants thank the Office for withdrawing the rejections set forth in the previous Office Action. The Office maintained provisional rejections of the claims for obviousness-type double patenting in view of 10/539,058 (pending); 11/311,134 (pending); and 11/311,147 (now U.S. Patent No. 7,691,256).

Applicants' arguments submitted on November 18, 2010, pointed out that the present application, i.e., 10/538,886 (having a U.S. filing date of December 12, 2003), is the senior application (i.e., earlier-filed application) in view of the 11/311,134 application which has a U.S. filing date of December 20, 2005. Applicants pointed out that under M.P.E.P. § 804(I)(B)(1) the rejection in view of at least 11/311,134 should be withdrawn to permit the earlier-filed application to issue as a patent without a terminal disclaimer. The Office responded as follows:

> Since there are more than two obvious-type double patenting rejections, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. In this instant case, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed. It is not effective to link the other two applications to each other.

See lines 14-20 on page 4 of the December 23, 2010 Office Action.

It appears that the Office is quoting the last paragraph of M.P.E.P. § 804(I)(B)(1) which is reproduced below in its complete form for convenience:

> Where there are three applications containing claims that conflict such that an ODP rejection is made in each application based upon the other two, it is not sufficient to file a terminal disclaimer in only one of the applications addressing the other two applications. Rather, an appropriate terminal disclaimer must be filed in at least two of the applications to link all three together. This is because a terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application in which the terminal disclaimer is filed; it is not effective to link the other two applications to each other.

Importantly, the above-quoted guidelines apply to multiple ODP rejections made "in each application based upon the other two". In the present application the Office rejected the claims for obviousness-type double patenting in view of 11/311,134. However, in the 11/311,134 application no obviousness-type double patenting rejection is made in view of either the present application or the 10/539,058 or 11/311,147 applications. The ODP rejection is therefore not made in each application.

The following guidelines from M.P.E.P. § 804(I)(B)(1) thus apply:

> If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

Applicants thus submit it is appropriate for the Office to withdraw the obviousness-type double patenting rejection from the present application and respectfully request that the Office do so.

Applicants submit the obviousness-type double patenting rejection in view of the 11/311,137 application (now U.S. 7,691,256 - "the '256 patent") should be withdrawn in view of the substantial differences between the process of the '256 patent and the process of

the present claims. The differences between the respective claims can be illustrated, in embodiments, by a comparison of the figures of the present application with the figure of the '256 patent. Figure 1 from both the present application and the '256 patent are shown below for convenience.

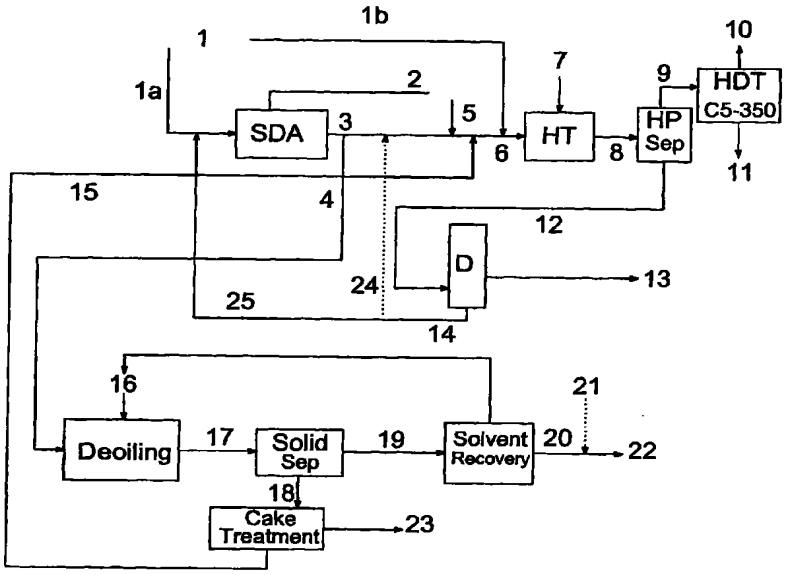

Figure 1 - Present Application (U.S. 2006/175229)

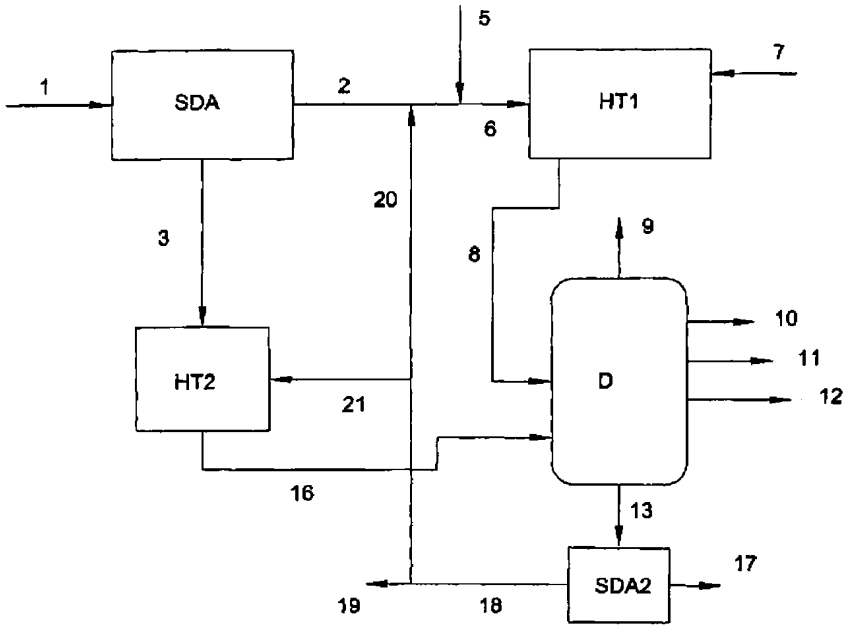

Figure 1 - U.S. 7,691,256

Of interest are the respective flows between the units "SDA", "HT1" and "D" which represent the deasphalting hydroconversion, and distillation steps recited in the respective claims. It is readily evident that Figure 1 of the '256 patent describes a process in which a deasphalting section ("SDA") forms *two streams of different composition* (i.e., reference numerals 2 and 3). The streams are separately hydroprocessed in units HT1 and HT2, respectively.

The '256 process scheme contrasts with Figure 1 of the present application which describes a deasphalting unit producing *a single stream of a single composition* identified as reference numeral 3 which is conveyed to a single-hydroprocessing unit HT. Subsequent to hydroprocessing in the HT unit the resultant product is subjected to a high pressure separation "HP" before treatment in a distillation unit "D".

In Figure 1 of the present application only a single process stream enters the distillation unit D. This contrasts with Figure 1 of the '256 patent in which two different streams each subjected to a hydroprocessing, i.e., HT1 and HT2, are separately conveyed to a distillation unit. The '256 process thus differently treats process streams of different composition.

A portion of the residue of distillation in the '256 process subjected to further deasphalting in unit SDA2 and a portion of the thus-formed product may be recirculated to a single hydroprocessing HT1. This is again in contrast to the process diagram shown in Figure 1 of the present application. The residue from distillation identified as reference numeral 14 may be returned to the deasphalting unit SDA.

It is therefore evident that the Figure 1 of the '256 patent describes a process that uses an SDA unit to form two streams of different composition which are subsequently hydroprocessed in different units. In contrast, the deasphalting shown in Figure 1 of the present application forms a single stream identified as reference numeral 12 that is subjected to hydroprocessing.

The Office did not set forth a legally sufficient analysis to prove that the claims of the present application and the claims of the '256 patent are obvious over one another. The Office did nothing more than set forth a conclusory statement that any "minor variations" between the two sets of claims would have been obvious to one of skill in the art.

Applicants thus traverse the rejection for obviousness-type double patenting in view of the 11/311,147 application on both factual grounds (i.e., the differences between the respective processes are so great as to be not obvious), and for legal reasons (e.g., the Office failed to put forth a legally sufficient argument in support of the rejection).

Applicants submit herewith a Terminal Disclaimer over 10/539,058.

The filing of a Terminal Disclaimer is not an admission of obviousness. As held by the Federal Circuit in *Ortho Pharmaceutical Corp. v. Smith*: "In legal principle, the filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption or estoppel on the merits of the rejection. It is improper to convert the simple expedient of "obviation" into an admission or acquiescence or estoppel on the merits".

Applicants respectfully request withdrawal of the rejection for obviousness-type double patenting in view of 11/311,137 (U.S. 7,691,256).

For the reasons discussed above in detail, Applicants respectfully request withdrawal of the rejection and the allowance of all now-pending claims.

Respectfully submitted,

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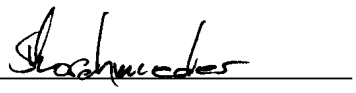

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